UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,443	05/03/2001	Osamu Ichiyoshi	Q64369	5717

7590 04/14/2006	EXAMINER
SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue, N.W. Washington, DC 20037	BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 January 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) <u>5</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-4 and 6-14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 24, 2006 has been entered.

Response to Amendment

2. The amendment filed on January 24, 2006 has been fully considered but are moot in view of the new grounds of rejection.

- Claims 1-4 and 6-14 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another

who has fulfilled the requirements of paragraphs (1), (2), and (4) of
section 371(c) of this title before the invention thereof by the applicant
for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments

Act of 2002 do not apply when the reference is a U.S. patent resulting directly or

indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e)

prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.   Claims 1-4, 6-11 and 14 are rejected under 35 U.S.C. 102(e)
as being anticipated by Voit et al USPN (6205139).

As per claim 1 Voit teaches a computer communication

network(fig.1) , comprising: a first computer (computer 21)

identified by an address recognizable by a telephone network

when the first computer connects to the telephone network "the

server 27 may comprise a modem bank coupled to the public

switched telephone network (not shown) and coupled through a

high speed link to an IP router within the network 31. In such

an implementation, the PCs 21 and 29 would have analog modems

for dial-up communications with the server 27" (col. 10, lines

6-13. See also col. 10, lines 47-62);   a

second computer (computers 35 and 36 fig. 1) identified by an

address recognizable by the telephone network when the second

computer connects to the telephone network "Many of the PCs also have voice communication capabilities. For example, PCs 21, 35, and 36 include microphones 23, 37, and 38 and speakers 25, 39, and 40. These PCs also include analog to digital and digital to analog converters, and the CPUs in such PCs run software for compression and decompression of digitized audio (typically voice) information." (col. 10, lines 36-62);

address server (server 51, fig. 1) for correlatively storing the address defined in the telephone network and a name corresponding to the address (The server 51 receives the a domain name query from the public packet data network 31. In response, the server may execute a direct look-up table based translation to an IP address or telephone number col. 11, lines 50 to col. 12, line 2 and col. 13, lines 10-20), wherein the first computer is configured to request from the address server an address by transmitting a name of the second computer, and is configured to communicate with the second computer using the address received from the address server "In its simplest form, if the conditional analysis produces a first result, the server 51 translates a name included in the query (e.g., domain name or telephone number based name) into a first destination IP address. If the conditional analysis produces a second result, the server 51 translates the name included in the query into a

second destination IP address. The server then transmits a

response message containing the first or the second destination

address to a calling PC. The PC uses the received IP address to

establish the desired communication through the public packet

data network 31 col. 12, lines 2-26 and col. 13, lines 1-20. See

also col. 27, lines 37 to col. 28, line 12)

As per claim 2, Voit teaches a computer communication network

according to claim 1, wherein the addresses recognizable by the

telephone are not Internet protocol address [using telephone

number to communicate implies using addresses other than IP

Protocol].

As per claim 3, Voit teaches a computer communication network

according to claim 1, wherein the addresses recognizable network

are telephone number [col. 31, lines 10-20].

As per claim 4, Voit teaches a computer communication network

according to claim 1, wherein the addresses recognizable by the

telephone network are numbers in an Integrated Service Digital

Network [col. 9, lines 63 to col. 10, line 5 and col. 11, lines

11-21].

As per claim 6, Voit teaches a computer communication network according to claim 1,where the names in the computer communication network are not duplicated nor the same name as domain names in the Internet (unique telephone number based name such as "301-608-2908@phone are used col. 13, lines 1-9).

As per claim 7, Voit et al teach a computer communication network according to claim 1, wherein the address server is an exchanger [server 51,].

As per claim 8 and 11, Voit teaches a method and a system for communications on a computer network (fig. 1 and abstract), comprising:

    providing a first network (the network of computers **21**,29 and access server 27 of fig. 1);

    providing a second network (network 31);

    providing a first computer identified by a unique address when connected to at least the first network (the server 27 may comprise a modem bank coupled to the public switched telephone network (not shown) and coupled through a high speed link to an IP router within the network 31. In such an implementation, the PCs 21 and 29 would have analog modems for dial-up communications with the server 27" (col. 10, lines 6-13. See

also col. 10, lines 47-62);

providing at least one second computer identified by a unique address when connected to at least the first network (the network of computers 21, **29** and access server 27 of fig. 1

providing a server (server 51) on at least the second network (network 31, fig. 1);

communicating with the server from the first computer to initially determine the address of the at least one second computer by communicating on the second network (The server 51 receives the a domain name query from the public packet data network 31. In response, the server may execute a direct look-up table based translation to an IP address or telephone number col. 11, lines 50 to col. 12, line 2 and col. 13, lines 10-20); and

connecting to the at least one second computer on the first network using the address of the at least one second computer provided by the server (In its simplest form, if the conditional analysis produces a first result, the server 51 translates a name included in the query (e.g., domain name or telephone number based name) into a first destination IP address. If the conditional analysis produces a second result, the server 51 translates the name included in the query into a second destination IP address. The server then transmits a response

message containing the first or the second destination address

to a calling PC. The PC uses the received IP address to

establish the desired communication through the public packet

data network 31 col. 12, lines 2-26 and col. 13, lines 1-20. See

also col. 27, lines 37 to col. 28, line 12); where the first

network is a telephone network (the server 27 may comprise a

modem bank coupled to the public switched telephone network (not

shown) and coupled through a high speed link to an IP router

within the network 31. In such an implementation, the PCs 21 and

29 would have analog modems for dial-up communications with the

server 27" (col. 10, lines 6-13. See also col. 10, lines 47-62).

As per claims 14, Voit teach computer communication network

according to claim 1, wherein if the inquiring of the address

server about the address corresponding to the name of the

computer on the terminating side returns a Public Switched

Telephone Network (PSTN) number, then the communication with the

terminating side computer is in PSTN mode, and

wherein if the inquiring of the address server about the address

corresponding to the name of the computer on the terminating

side returns an Internet Protocol (1P) address, then the

communication with the terminating side computer is in IP mode

(col. 10, lines 47 to col. 11, line 42 and col. 26,lines 6-).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which

forms the basis for all obviousness rejections set forth in this

Office action:

> (a) A patent may not be obtained though the invention is
> not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by
> the manner in which the invention was made.

4.   Claims 9-10 and 12-13 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Voit USPN. (6205139) in view of

Yablon USPN. (5764731).

As per claim 9 and 12, Although Voit et al shows substantial

features of the claimed invention, he does not explicitly show

storing the address of the at least one second computer on the

first computer so that subsequent connections to the at least

second computer do not require communicating with the Server.

Nonetheless, this feature is well known in the art and would

have been an obvious modification of the system disclosed by

Voit et al, as evidenced by Yablon USPN. (5764731).

In analogous art, Yablon whose invention is about an enhanced

system for transferring, storing and using signaling information in a switched network, discloses storing the address (telephone number) of the at least one second computer (second telephone device) on the first computer (on the memory of first telephone device) so that subsequent connections to the at least second computer do not require communicating with the Server. [Col. 12, lines 3-40 and col. 23, lines 1-19]. Giving the teaching of Yablon, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Voit et al by employing the system of Yablon. One would be motivated to do so because it provides user a quick way of establishing communications with other user devices absent of server intervention [col. 23, lines 1-19]

As per claims 10 and 13, Yablon as modified shows the connection to the at least second computer on the first network does not use a second network (primary user and secondary user of fig. 7 of Yablon user direct communication without internet or another second network).

Conclusion

5.   The prior made of record and not relied upon is considered pertinent to applicant's disclosure.
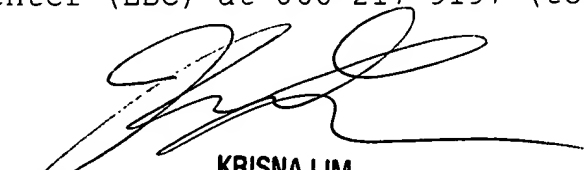
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained form the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB Art Unit 2153

KRISNA LIM
PRIMARY EXAMINER